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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,391	01/08/2002	Eiji Shiojiri	215409US0	9970

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EXAMINER

KAM, CHIH MIN

ART UNIT PAPER NUMBER

1653

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/926,391

Applicant(s)

SHIOJIRI ET AL.

Examiner

Chih-Min Kam

Art Unit

1653

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-19.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: Interview Summary attached

Continuation of 2. NOTE: The amendment to the claims does not resolve the current issues under 35 USC 112, second paragraph, it also raise new issues regarding whether the formula (1) in claim 1 is a peptide or an amino acid compound. In the amendment of July 20, 2004, claim 1 has been amended to cite n is 0, and R7 is a hydrogen, specific amino acid side chain, or C1-C6 alkyl group; and claim 2 has been cancelled, and new claims 20-41 have been added. Applicants' response has been fully considered, however, claims 1 and 3-23 are rejected under 35 USC 112, second paragraph.

If applicants' amendment were entered, it would have the following response:

1. Claims 1 and 3-23 are rejected under 35 USC 112, second paragraph as being indefinite because of the term "a peptide having a naphthyl group and represented by the formula (1)", the cited term renders the claim indefinite, it is not clear whether the formula (1) is a peptide or an amino acid compound because claim 1 cites n is 0, and m is 0 or 1 in formulas (1) and (2), and if m is 0, the formula (1) becomes $\text{Ar-C(=O)-N(R2)-C(R3)(R4)-X2-C(=O)-X3-R9}$, which is an amino acid derivative, not a peptide as indicated by the claim. Claims 3-23 are included in the rejection because they are dependent on rejected claims and do not correct the deficiency of the claim from which they depend.

2. Claims 3 and 20-23 are indefinite because claim 3, for example, cites "said peptide represented by Formula (1) is D-1-naphthylalanyl-Arg-LeuNH2.....or L-2-naphthylalanyl-Arg-LeuNH2" in lines 2-4, and there is no antecedent base in the claim. Formula (1) contains Ar(C=O) group, thus the compound can only be "naphthoyl-containing" amino acid or dipeptide, not the tripeptide indicated in the claim. See also claims 20-23.

Continuation of 3. Applicant's reply has overcome the following rejection(s): If entered, the rejection of claims 1, 2 and 4-19 under 35 USC 112, first paragraph, and the rejection of claims 1, 4, 8-11 and 16-19 under 35 USC 102 (b).

Continuation of 5. does NOT place the application in condition for allowance because: The amendment to the claims does not resolve current issues under 35 USC 112, second paragraph.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (571) 272-0948. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached at 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chih-Min Kam, Ph. D. *CMK*
Patent Examiner

CMK
August 13, 2004

Jon P. Weber
Jon P. Weber, Ph.D.
Primary Examiner